

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:)	Attorney Docket No. 72167.000253
)	
Tom VICKNAIR)	Confirmation No. 5053
)	
Application Number: 09/728,340)	TC/A.U.: 3693
)	
Filed: December 1, 2000)	Examiner: Harish T. Dass
)	
)	Customer No. 21967

For: ELECTRONIC CHECK PRESENTMENT
SYSTEM AND METHOD HAVING AN
ITEM SEQUENCE CAPABILITY

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

TABLE OF CONTENTS

	<u>PAGE</u>
I. REAL PARTY IN INTEREST	2
II. RELATED APPEALS AND INTERFERENCES.....	2
III. STATUS OF CLAIMS	2
IV. STATUS OF AMENDMENTS	2
V. SUMMARY OF CLAIMED SUBJECT MATTER	3
A. Summary of the Invention	3
B. Embodiments of the Claimed Invention	4
1. Independent Claim 1	4
2. Independent Claim 36.....	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	6
VII. ARGUMENTS.....	6
A. Brief Description of the Art Applied to the Claims.....	6
1. U.S. Patent No. 5,930,778 to Geer.....	6
2. U.S. Patent No. 5,532,464 to Josephson.....	7
3. U.S. Patent No. 5,678,046 to Cahill.....	7
4. U.S. Patent No. 5,502,576 to Ramsay.....	8
B. Summary of Argument	8
C. The Specification Provides Antecedent Basis for the Claimed Subject Matter.....	9
D. Independent Claim 1 is Patentable Over Geer, Josephson, Cahill and Ramsay under 35 U.S.C. 103(a)	11
1. The Combination of Four Disparate References to Geer, Josephson, Cahill and Ramsay all Fail to Properly Address Each and Every Claim Limitation of Independent Claim 1.....	11
2. The Office Action Fails To Provide a Proper Statement of Motivation	16
E. Independent Claim 36 is Patentable Over Geer, Josephson, Cahill and Ramsay under 35 U.S.C. 103(a)	20
1. The Combination of Four Disparate References to Geer, Josephson, Cahill and Ramsay all Fail to Properly Address Each and Every Claim Limitation of Independent Claim 36.....	20
2. The Office Action Fails To Provide a Proper Statement of Motivation	24
F. Dependent claims 2-6, 8-10, 37-41 and 43-45 are Each Separately Patentable Over Geer, Josephson, Cahill and Ramsay	28

1.	Claim 2 is Separately Patentable.....	28
2.	Claim 3 is Separately Patentable.....	29
3.	Claim 4 is Separately Patentable.....	29
4.	Claim 5 is Separately Patentable.....	29
5.	Claim 6 is Separately Patentable.....	30
6.	Claim 8 is Separately Patentable.....	30
7.	Claim 9 is Separately Patentable.....	30
8.	Claim 10 is Separately Patentable.....	31
9.	Claim 37 is Separately Patentable.....	31
10.	Claim 38 is Separately Patentable.....	31
11.	Claim 39 is Separately Patentable.....	32
12.	Claim 40 is Separately Patentable.....	32
13.	Claim 41 is Separately Patentable.....	32
14.	Claim 43 is Separately Patentable.....	33
15.	Claim 44 is Separately Patentable.....	33
16.	Claim 45 is Separately Patentable.....	33
VIII.	CONCLUSION.....	35

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/728,340 Confirmation No.: 5053
Applicant : Tom Vicknair
Filed : December 1, 2000
Title : ELECTRONIC CHECK PRESENTMENT SYSTEM AND
METHOD HAVING AN ITEM SEQUENCE CAPABILITY
TC/Art Unit : 3628
Examiner: : Harish T. Dass

Docket No. : 72167.000253
Customer No. : **21967**

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APPEAL BRIEF

Appellants' Appeal Brief in connection with the above-captioned patent application is hereby submitted. A check for the requisite fee in accordance with 37 C.F.R. § 1.17(c) concurrently submitted. A Notice of Appeal and a Request for Pre-Appeal Brief Conference were submitted on May 30, 2006. A Decision allowing the application to proceed to the Board of Patent Appeals and Interferences was mailed on October 2, 2006. It is respectfully submitted that this Appeal Brief is timely filed. Each item required by 37 C.F.R. § 41.37 is set forth below. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

In response to the Final Office Action dated February 28, 2006, rejecting pending claims 1-6, 8-10, 36-41 and 43-45, Appellants respectfully request that the Board of Patent Appeals and Interferences to reconsider and withdraw the rejection of record, and allow the pending claims, which are attached hereto as Appendix A.

I. REAL PARTY IN INTEREST

The real party in interest is the Chase Manhattan Bank, the assignee of the above-referenced application.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-6, 8-10, 36-41 and 43-45 are pending in the application. The rejections of each of claims 1-6, 8-10, 36-41 and 43-45 are appealed.

Claim 8 is objected to because it refers to a canceled claim.

IV. STATUS OF AMENDMENTS

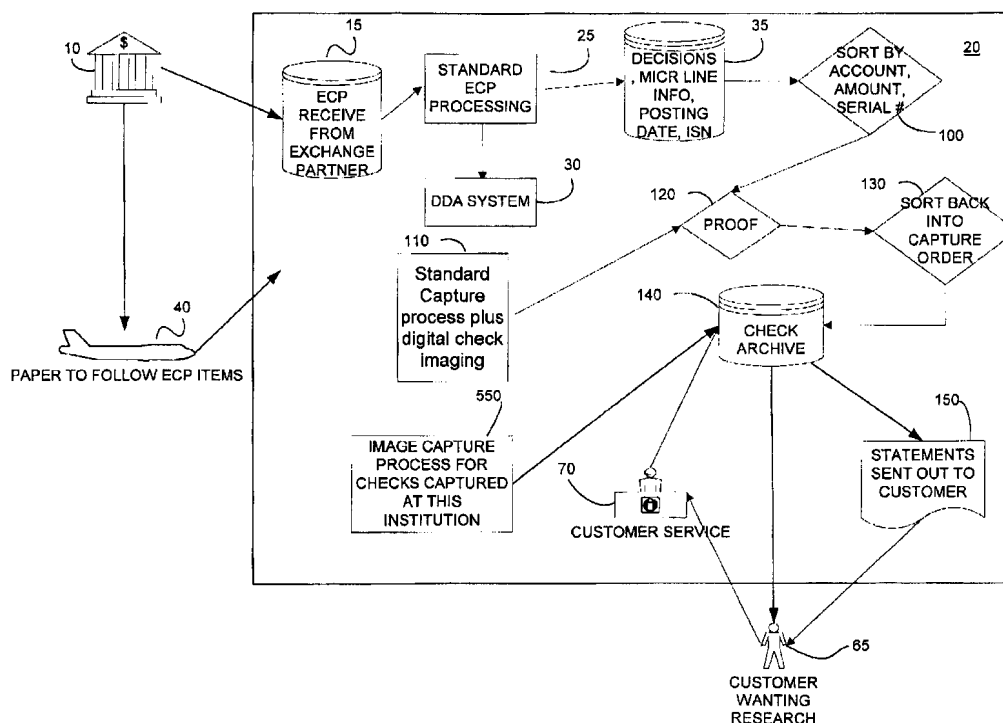
The Final Office Action objected to claim 8 as referring to a canceled claim. The Examiner *required* amendment to the claim. In the Response filed April 27, 2006, Appellants amended claim 8 to correct its dependency from canceled claim 7 to independent claim 1. Accordingly, the objection to claim 8 should be withdrawn. However, despite the Examiner's requirement for correction, the Examiner has refused entry of this amendment in the Advisory Action mailed May 23, 2006.

No other amendments to the claims have been filed subsequent to the rejection dated February 28, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Summary of the Invention

According to an embodiment of the present inventions, a system and method for Electronic Check Presentment (ECP) processing employs digital imaging techniques to digitally image the physical checks as they arrive subsequent to posting of the ECP items. Abstract. Figure 2 reproduced below. The transmitting bank 10 generates the ECP file 15 and transmits the ECP file 15 to the drawee bank 20. The drawee bank 20 performs ECP processing 25 and generates the item database 35 that contains all the information with respect to each ECP item, including a unique ISN number. [0029] The paper items 40 arrive at a later time. The images 110 are electronically linked to the data records that represent the checks. A new ISN can be generated by the sorters used in the capture process, where this ISN can be disregarded once the internal processes of the capture processes 110 have been completed. [0034] During the proofing process at 120, in which the data records for the ECP items 15 are validated against the data records for the physical items 40, the records are updated such that the posting date and ISN number for the data records for the physical items reflect the posting date and ISN number of the ECP items. [0035] As the digital image of the check is electronically linked to the data records, the image thus carries the posting date and ISN of the ECP item. [0040]



B. Embodiments of the Claimed Invention

1. Independent Claim 1

As recited in independent claim 1, a method of processing banking transactions comprises receiving an electronic cash presentment (ECP) file (Figure 2, 15, [0029]), the ECP file containing first records representing paper-based banking transactions [0029]; for each of the first records, assigning a unique first item sequence number to each respective first record (Figure 2, 35, [0029]); receiving the paper-based banking transactions after having received the ECP file (Figure 2, 40, [0031]); generating second records representing the paper-based banking transactions [0031]; generating digital images of the paper-based banking transactions (Figure 2, 110, [0031] [0032]); for each of the second records, assigning a unique second item sequence number to each respective second record [0034]; correlating the first and second records (Figure

2, 120, [0035] [0036]); and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number [0034].

2. Independent Claim 36

As recited in independent claim 36, a system for processing banking transactions comprises a first processor, the first processor receiving an electronic cash presentment (ECP) file (Figure 2, 15, [0029]), the ECP file containing first records representing paper-based banking transactions [0029], the first processor assigning a unique first item sequence number to each respective first record (Figure 2, 35, [0029]); a second processor, the second processor receiving the paper-based banking transactions after the first processor received the ECP file (Figure 2, 40, [0031]), the second processor generating second records representing the paper-based banking transactions [0031], the second processor assigning a unique second item sequence number to each respective second record [0034]; a scanner coupled to the second processor for generating digital images of the paper-based banking transactions (Figure 2, 100, [0031] [0032]); and a third processor correlating the first and second records (Figure 2, 120, [0035] [0036]) and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number [0034].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are as follows.

A. Whether the specification fails to provide proper antecedent basis for the claimed subject matter.

B. Whether claims 1-6, 8-10, 36-41 and 43-45 are unpatentable under 35 U.S.C. § 103(a) by U.S. Patent No. 5,930,778 to Geer, U.S. Patent No. 5,532,464 to Josephson, U.S. Patent No. 5,678,046 to Cahill and U.S. Patent No. 5,502,576 to Ramsay.

None of the claims stand or fall together. The reasons why each claim is separately patentable are presented in the Arguments section below.

VII. ARGUMENTS

The rejections against the pending claims under consideration in the above-captioned patent application should be reversed for at least the reasons set forth below.

A. Brief Description of the Art Applied to the Claims

1. U.S. Patent No. 5,930,778 to Geer

Geer appears to be directed to a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. Geer, Abstract. Financial instruments from customers are received by a payee, *e.g.*, bank customer 2, at an item capture facility remote from the payee's depository bank 10 in which the submission of the instruments into the payment system is coordinated with the payee's internal accounting process. Geer, Figure 2, col. 6, lines 50-67.

2. U.S. Patent No. 5,532,464 to Josephson

Josephson appears to be directed to an electronic check presentment system having a return item notification system that provides banks with a fully automated capability to receive early notification of checks that it previously presented to a payor bank and that have subsequently been identified by the payor bank as return checks or unpaid items. Josephson, Abstract. The Electronic Check Presentment System of Josephson allows banks utilizing it to transmit return notifications to downstream correspondent banks and customers. Josephson, Abstract. As shown in Figure 1 of Josephson, Partner banks 101A and 101B participate in an Electronic Check Clearing House Organization (ECCHO) Exchange Program 103. Josephson, col. 11, lines 3-21. Each Partner bank has a check processing control system (CPCS) 107. Partner banks 101A and 101B receive paper checks 111, usually deposited by their respective customers. After their deposit or cashing, the checks are “captured” by the CPCS or IPS 107. Josephson, col. 11, lines 22-26.

3. U.S. Patent No. 5,678,046 to Cahill

Cahill appears to be directed to a method and apparatus for distributing files on a file storage device. Cahill, Abstract. The method of Cahill purports to involve placing a plurality of documents in a document imaging machine, forming an electronic image of each document, storing each electronic image in an electronic storage device and providing a user interface device in communication on a communication link with the electronic storage device. Cahill, Abstract. As shown in Figure 1, the electronic check image storage and retrieval system includes a check image archive system 8 and remote customer workstations 7. Cahill, col. 12, lines 39-48. System 8 includes a sort station 2 that receives checks 1, generates digital images, decodes

the MICR line and sorts them to one of a plurality of pockets. Cahill, col. 12, lines 49-53. The sort station 2 is coupled to a network 3 which is coupled to a repair station 4, an image storage station 5 and an output station 6. Cahill, col. 12, lines 54-58.

4. U.S. Patent No. 5,502,576 to Ramsay

Ramsay appears to be directed to a method and apparatus for transmission, storage and retrieval of documents in an electronic domain. The method and apparatus of Ramsay purports to provide high speed conversion of tangible source documents to electronic images and subsequent transmission or storage and retrieval of images, utilizing hybrid signal processing. Ramsay, Abstract.

The applied reference fails to show or obviate the combination of claim limitations, as recited by Appellants.

B. Summary of Argument

The specification is improperly objected to as failing to provide proper antecedent basis for the claimed subject matter.

Claims 1-6, 8-10, 36-41 and 43-45 are improperly rejected under 35 U.S.C. § 103(a) by U.S. Patent No. 5,930,778 to Geer, U.S. Patent No. 5,532,464 to Josephson, U.S. Patent No. 5,678,046 to Cahill and U.S. Patent No. 5,502,576 to Ramsay because the Office Action fails to set forth a *prima facie* case of obviousness. In addition, the combination of Geer, Josephson, Cahill and Ramsay fails to show the claimed inventions.

C. The Specification Provides Antecedent Basis for the Claimed Subject Matter

The Specification is currently objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action alleges that the limitation “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number” is not supported by the specification. Appellants respectfully disagree.

According to MPEP 608.01(g), the description is a dictionary for the claims and should provide *clear support* or antecedent basis for all terms used in the claims. *See* 37 CFR 1.75. Further, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). In this case, the claim limitation at issue which recites “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number” was presented in the original application at the time of filing. In addition, support for this claim limitation may be found in paragraph [0034] which states:

“A further advantage of the prior art that will become more evident as described below, is that a new ISN does not have to be generated for each physical item in the batch 40 from the transmitting bank 10. Although such an ISN can be generated by the sorters used in the capture process 10, this ISN can be disregarded once the internal processes of the capture processes 110 have been complete.”

Additional support is found in paragraphs [0037] as well as [0040] which state:

In the most significant improvement over the prior art, the electronic file from the capture process 110 that documents the physical items that were received, contains the digital images of the physical items. This is significant since records associated with the digital images can be updated to reflect the standard ECP processing 25. Specifically, as the digital images are matched to ECP items, the

digital images are assigned the posting ISN and posting date given to the item when it was presented via the ECP process.

The present invention solves these problems with prior art by processing all Paper to Follow items in a strictly digital format. Most significantly, the digital images of the items, and the data records associated with the images are modified to reflect the financial processing (e.g., the posting date and posting ISN) that has occurred with respect to an item. *Since the digital records and images of the physical items are now linked directly to the ECP items, searching for an image of an item is a direct process.*

As supported by paragraph [0008], the ISN (Item Sequence Number) is unique for each item and serves as an *internal index* by which a bank can track an item. In addition, words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. MPEP 2111.01. It is believed that the specification as originally filed provides *clear support* for the originally presented claim limitation reciting “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.” In addition, the claim limitation itself explains that the step of “discarding” is performed “*such that the second records are indexable according to the first item sequence number.*”

The Examiner alleges that the original specification fails to allow the Examiner to properly understand the claimed limitation and perform a proper search. page 7, Final Office Action mailed February 28, 2006. This simply untrue. As detailed above, the specification clearly supports and explains the limitation at issue. In addition, the claim limitation at issue was originally presented in the filed application. Therefore, there is a strong presumption of an adequate description of the claim limitation at issue. Further, the plain meaning of the term “discarding” makes clear that the second item sequence numbers are simply not used or

disregarded. Finally, the claim limitation itself explains that the step of “discarding” is performed “*such that the second records are indexable according to the first item sequence number.*” Therefore, contrary to the Examiner’s viewpoint, the specification is not missing a processing step.

This objection to the specification was newly presented in the Final Office Action mailed February 28, 2006. Appellants fully addressed this objection in the Response to the Final Office Action filed April 27, 2006. In the following Advisory Action, the Examiner fails to make any attempt to address Appellant’s response to the objection made for the first time in the Final Office Action of February 28, 2006, despite Appellants request for full and fair consideration of Appellant’s remarks to the new objection to the Specification.

D. Independent Claim 1 is Patentable Over Geer, Josephson, Cahill and Ramsay under 35 U.S.C. 103(a)

Claims 1-6, 8-10, 36-41 and 43-45 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,930,778 to Geer (“Geer”) in view of U.S. Patent No. 5,532,464 to Josephson (“Josephson”), U.S. Patent No. 5,678,046 to Cahill *et al* (“Cahill”) and U.S. Patent No. 5,502,576 to Ramsay *et al* (“Ramsay”). For at least the reasons stated below, independent claim 1 is clearly patentable over the combination of Geer, Josephson, Cahill and Ramsay.

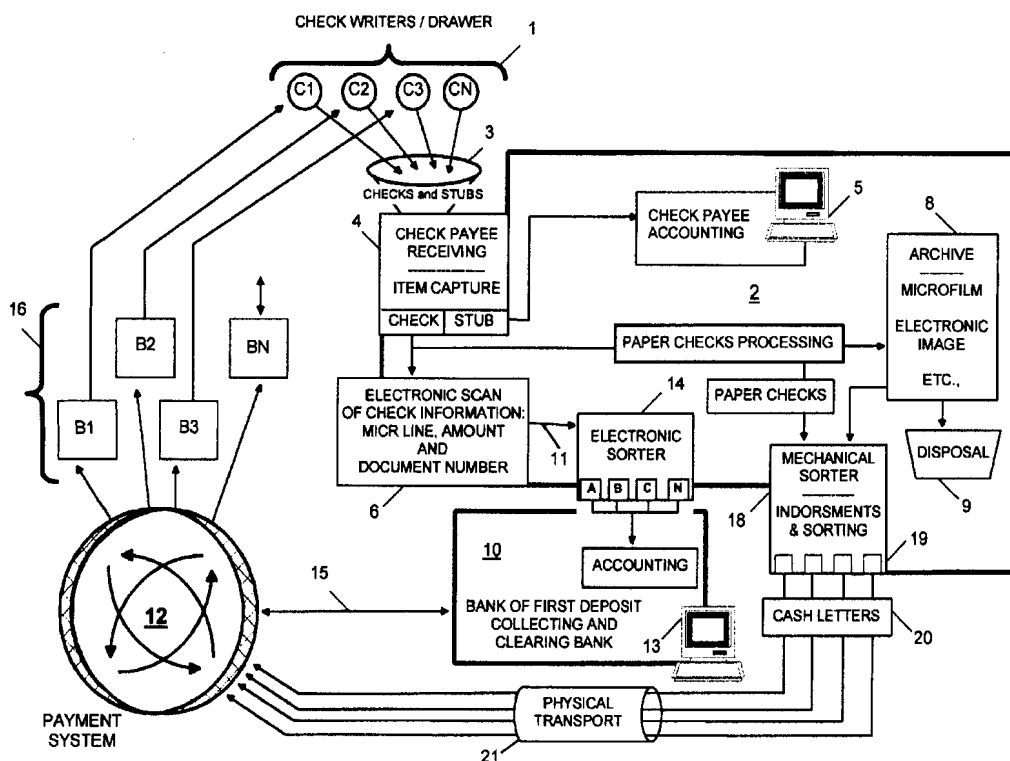
1. The Combination of Four Disparate References to Geer, Josephson, Cahill and Ramsay all Fail to Properly Address Each and Every Claim Limitation of Independent Claim 1

Geer purports to disclose a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. The system and

process of Geer appear to relate to the collection of funds represented by financial instruments that are received by a payee at an item capture facility remote from the payee's depository bank. Geer, Abstract. As illustrated in Figure 2 of Geer, reproduced below, Geer's system relates to the processing conducted at a bank customer 2, which is a public utility such as a telephone company, or other business entity receiving a large number of periodic payments from numerous customers. Geer, col. 6, lines 50-53. In other words, any payment processing at the payor banks 16 (or the drawee bank) is simply not disclosed by Geer. As the system of Geer which is directed to processing performed at a bank customer, remote from the banks itself, is fundamentally different from the processing performed at the payee bank of the embodiments of Appellants' invention, many of the claim features are simply not shown by Geer. Further, any proposed modification to meet the missing claim limitations is simply not supported by the disclosure of Geer and is, in fact, contrary to the teachings of Geer.

Geer does not show "**receiving** an electronic cash presentment (ECP) file, the ECP file containing first records representing paper-based banking transactions." As the subject matter of Geer and the embodiments of the claimed inventions are directed to different types of processing within divergent payment cycles, Geer does not "receive" an ECP file at the bank customer 2 location, instead individual customer checks and remittance data are received from individual customers C1, C2, C3 and CN at a Check Receiving unit 4. As shown, cash letters 20 are transmitted from bank customer 2 and are thus clearly not received by bank customer 2. Geer provides little, if any, details concerning processing at Payor Banks 16.

In addition, Geer further fails to show “receiving the paper-based banking transactions *after having received the ECP file.*”¹ The excerpt relied upon by the Office Action fails to show that paper-based banking transactions are received *after* the ECP file. As the ECP file is never received by bank customer 2 in the Geer disclosure, the paper-based banking transactions are not received “after having received the ECP file.”



The Office Action admits the major deficiencies of Geer. More specifically, it is undisputed that Geer fails to show at least the steps of “*correlating the first and second records*” and “*discarding the second item sequence numbers such that the second records are indexable*”

¹ The prior Non Final Office Action mailed February 4, 2005 readily admits that Geer does not disclose at least this limitation, see page 3.

according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.”

The Office Action relies on a combination of three disparate references to Josephson, Cahill and Ramsay in an attempt to address the admitted major deficiencies of Geer. For at least the reasons stated below, the three secondary references all fail to address the combination of claim limitations.

The Office Action purports that Josephson discloses “correlating the first and second records.” The Office Action relies on various excerpts of Josephson which all fail to properly address this limitation and further refers to “correlated item sequence numbers assigned ...” from Josephson. See page 4, Final Office Action. It is unclear as to what excerpt in Josephson discloses “correlated item sequence numbers assigned ...” as this phrase is not used in the entire Josephson reference. In addition, the disclosure of Josephson is contrary to the claim limitations. More specifically, Josephson states that the ECP System 105 reconciles the electronic and the paper cash letters with the MICR line data. Josephson, col. 12, lines 12-15. Therefore, Josephson teaches away from the embodiments of the claimed invention which recite “correlating the first and second records” and further teachings against the ability to “discard[ing] the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.” As Josephson teaches reconciliation with MICR line data, second item sequence numbers are never assigned nor are they ever subsequently discarded.

As is understood, “the prior art as a whole must be considered ... [t]he teachings are to be viewed as they would have been viewed by one of ordinary skill.” *In re Hedges*, 783, F.2d 1038, 1041 (Fed. Cir. 1986). In addition, “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA, 1965)).

The Office Action turns to Cahill to teach “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.” As shown in Figures 3 and 5, Cahill shows a storage device 202 at sort station 2 with a temporary storage of check images and associated data before the image is provided on network 3. After index records 28 are written, TIFF files 22 are deleted from storage space 505. Cahill does not assign a unique second item sequence number to second records, correlate the first and second records and further discard the second item sequence numbers such that records are indexable according to the first record number. The Office Action alleges that Cahill discloses that the TIFF files are deleted, but there is no mention of assigning a second item sequence number or discarding the second item sequence number. The Office Action has failed to show how deleting TIFF files in Cahill is equivalent to the claimed steps of “*for each of the second records, assigning a unique second item sequence number to each respective second record;*” “*correlating the first and second records;*” and “*discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein*

the second records and the digital images are linked to the first records by the first item sequence number.”

Finally, the Office Action relies upon a fourth reference, Ramsay, to allegedly address the deficiencies of Geer, Josephson and Cahill. More specifically, the Office Action alleges that Ramsay discloses “wherein the second records and the digital images are linked to the records by the first item sequence number.” page 5, Office Action mailed February 28, 2006. Ramsay is directed to the transmission, storage and retrieval of documents in an electronic domain. Ramsay is not related to electronic check presentment or processing. Rather, Ramsay is directed to storage and retrieval of a two-dimensional electronic image expressible as a digital array or bitmap for the purpose of interactive document processing. Ramsay, Abstract, col. 42, lines 59-64. The disclosure of Ramsay is deficient in addressing the major differences between the claimed inventions and the applied art.

As demonstrated above, the combination of the four disparate references to Geer, Josephson, Cahill and Ramsay fails to address each and every claim limitation of independent claim 1.

2. The Office Action Fails To Provide a Proper Statement of Motivation

Based on the disparate and divergent disclosures of Geer, Josephson, Cahill and Ramsay, the Office Action summarily concludes that it would have been obvious to combine the disclosures of Geer and Ramsay “to capture the image of an item and assign a sequence number to the image,” without providing a basis for combining the disclosures. In addition, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson “to relate the image sequence number to serial number of the time (cross reference),” without providing any statement of motivation for making the suggested modification. Further, the

Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson with Cahill “for improved database managing of document retrieval using indexed record.” *See* page 5, Final Office Action mailed February 28, 2006. The Office Action has failed to provide a proper statement of motivation for combining four disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

In addition, each of the prior art references relied upon are directed to different processes within the entire payment cycle. For example, Geer is directed to processing performed at a bank customer site, which is remote from the payor bank and the payee bank. Josephson is directed to an ECP system. Cahill is directed to a file storage device, *e.g.*, check image archive system. Ramsay is directed to transmission, storage and retrieval of documents and is unrelated to the banking industry. The Office Action has taken unrelated concepts in the abstract in an effort to somehow forge together a rejection. In *In re Hedges*, 783, F.2d 1038, 1041 (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that “the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill.” The court also stated that “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA, 1965)).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” *Dembiczak*, 175 F.3d 994, 999 (Fed. Cir.

1999). Therefore, this Court has consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”). In this case, such a showing is completely lacking.

The proposed rejections are classic examples of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”).

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed.

Ruiz v. A.B. Chance Co., 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for combining Geer, Josephson, Cahill, and Ramsay has absolutely nothing to do with the deficiencies of Geer. As admitted by the Office Action, Geer fails to show at least the steps of "correlating the first and second records" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." To properly modify Geer to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Geer. Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Geer as taught by Josephson, Cahill and Ramsay, so the proposed modification fails. In fact, Geer, Josephson, Cahill and Ramsay are improperly combined and lack proper motivation. Even if the combination of Geer, Josephson, Cahill and Ramsay could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Appellants.

The mere fact that Geer, Josephson, Cahill and Ramsay can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir.

1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Furthermore, the fact that four disparate references are needed in combination to address Appellants' claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, *Chisum on Patents* §5.04[I][e][6] (2002).

E. Independent Claim 36 is Patentable Over Geer, Josephson, Cahill and Ramsay under 35 U.S.C. 103(a)

In a similar manner, independent claim 36 is also patentable over Geer, Josephson, Cahill and Ramsay for at least the reasons stated below.

1. The Combination of Four Disparate References to Geer, Josephson, Cahill and Ramsay all Fail to Properly Address Each and Every Claim Limitation of Independent Claim 36

Geer purports to disclose a system for expediting the clearing of financial instruments and coordinating the same with invoice processing at the point of receipt. The system and process of Geer appear to relate to the collection of funds represented by financial instruments that are received by a payee at an item capture facility remote from the payee's depository bank. Geer, Abstract. As illustrated in Figure 2 of Geer, reproduced above, Geer's system relates to the processing conducted at a bank customer 2, which is a public utility such as a telephone company, or other business entity receiving a large number of periodic payments from numerous customers. Geer, col. 6, lines 50-53. In other words, any payment processing at the payor banks 16 (or the drawee bank) is simply not disclosed by Geer. As the system of Geer which is

directed to processing performed at a bank customer, remote from the banks itself, is fundamentally different from the processing performed at the payee bank of the embodiments of Appellants' invention, many of the claim features are simply not shown by Geer. Further, any proposed modification to meet the missing claim limitations is simply not supported by the disclosure of Geer and is, in fact, contrary to the teachings of Geer.

Geer does not show "a first processor, the first processor *receiving* an electronic cash presentment (ECP) file, the ECP file containing first records representing paper-based banking transactions." As the subject matter of Geer and the embodiments of the claimed inventions are directed to different types of processing within divergent payment cycles, Geer does not "receive" an ECP file at the bank customer 2 location, instead individual customer checks and remittance data are received from individual customers C1, C2, C3 and CN at a Check Receiving unit 4. As shown, cash letters 20 are transmitted from bank customer 2 and are thus clearly not received by bank customer 2. Geer provides little, if any, details concerning processing at Payor Banks 16.

In addition, Geer further fails to show "a second processor, the second processor receiving the paper-based banking transactions *after having received the ECP file.*"² The excerpt relied upon by the Office Action fails to show that paper-based banking transactions are received *after* the ECP file. As the ECP file is never received by bank customer 2 in the Geer disclosure, the paper-based banking transactions are not received "after having received the ECP file."

The Office Action admits the major deficiencies of Geer. More specifically, it is undisputed that Geer fails to show at least "a third processor *correlating the first and second*

² The prior Non Final Office Action mailed February 4, 2005 readily admits that Geer does not disclose at least this limitation, see page 3.

records and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.”

The Office Action relies on a combination of three disparate references to Josephson, Cahill and Ramsay in an attempt to address the admitted major deficiencies of Geer. For at least the reasons stated below, the three secondary references all fail to address the combination of claim limitations.

The Office Action purports that Josephson discloses “correlating the first and second records.” The Office Action relies on various excerpts of Josephson which all fail to properly address this limitation and further refers to “correlated item sequence numbers assigned ...” from Josephson. See page 4, Final Office Action. It is unclear as to what excerpt in Josephson discloses “correlated item sequence numbers assigned ...” as this phrase is not used in the entire Josephson reference. In addition, the disclosure of Josephson is contrary to the claim limitations. More specifically, Josephson states that the ECP System 105 reconciles the electronic and the paper cash letters with the MICR line data. Josephson, col. 12, lines 12-15. Therefore, Josephson teaches away from the embodiments of the claimed invention which recite “a third processor correlating the first and second records” and further teachings against the ability to “discard[ing] the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.” As Josephson teaches reconciliation with MICR line data, second item sequence numbers are never assigned nor are they ever subsequently discarded.

As is understood, “the prior art as a whole must be considered ... [t]he teachings are to be viewed as they would have been viewed by one of ordinary skill.” *In re Hedges*, 783, F.2d 1038, 1041 (Fed. Cir. 1986). In addition, “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA, 1965)).

The Office Action turns to Cahill to teach “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number.” As shown in Figures 3 and 5, Cahill shows a storage device 202 at sort station 2 with a temporary storage of check images and associated data before the image is provided on network 3. After index records 28 are written, TIFF files 22 are deleted from storage space 505. Cahill does not assign a unique second item sequence number to second records, correlate the first and second records and further discard the second item sequence numbers such that records are indexable according to the first record number. The Office Action alleges that Cahill discloses that the TIFF files are deleted, but there is no mention of assigning a second item sequence number or discarding the second item sequence number. The Office Action has failed to show how deleting TIFF files in Cahill is equivalent to the claimed “second processor *assigning a unique second item sequence number to each respective second record*” and “a third processor *correlating the first and second records and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.*”

Finally, the Office Action relies upon a fourth reference, Ramsay, to allegedly address the deficiencies of Geer, Josephson and Cahill. More specifically, the Office Action alleges that Ramsay discloses “wherein the second records and the digital images are linked to the records by the first item sequence number.” page 5, Office Action mailed February 28, 2006. Ramsay is directed to the transmission, storage and retrieval of documents in an electronic domain. Ramsay is not related to electronic check presentment or processing. Rather, Ramsay is directed to storage and retrieval of a two-dimensional electronic image expressible as a digital array or bitmap for the purpose of interactive document processing. Ramsay, Abstract, col. 42, lines 59-64. The disclosure of Ramsay is deficient in addressing the major differences between the claimed inventions and the applied art.

As demonstrated above, the combination of the four disparate references to Geer, Josephson, Cahill and Ramsay fails to address each and every claim limitation of independent claim 36.

2. The Office Action Fails To Provide a Proper Statement of Motivation

Based on the disparate and divergent disclosures of Geer, Josephson, Cahill and Ramsay, the Office Action summarily concludes that it would have been obvious to combine the disclosures of Geer and Ramsay “to capture the image of an item and assign a sequence number to the image,” without providing a basis for combining the disclosures. In addition, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson “to relate the image sequence number to serial number of the time (cross reference),” without providing any statement of motivation for making the suggested modification. Further, the Office Action concludes that it would have been obvious to combine Geer and Ramsay with Josephson with Cahill “for improved database managing of document retrieval using indexed

record.” See page 5, Final Office Action mailed February 28, 2006. The Office Action has failed to provide a proper statement of motivation for combining four disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

In addition, each of the prior art references relied upon are directed to different processes within the entire payment cycle. For example, Geer is directed to processing performed at a bank customer site, which is remote from the payor bank and the payee bank. Josephson is directed to an ECP system. Cahill is directed to a file storage device, *e.g.*, check image archive system. Ramsay is directed to transmission, storage and retrieval of documents and is unrelated to the banking industry. The Office Action has taken unrelated concepts in the abstract in an effort to somehow forge together a rejection. In *In re Hedges*, 783, F.2d 1038, 1041 (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that “the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill.” The court also stated that “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (quoting *In re Wesslau*, 353 F.2d 238, 241 (CCPA, 1965)).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” *Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Therefore, this Court has consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to

combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”). In this case, such a showing is completely lacking.

The proposed rejections are classic examples of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”).

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will

solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for combining Geer, Josephson, Cahill, and Ramsay has absolutely nothing to do with the deficiencies of Geer. As admitted by the Office Action, Geer fails to show at least the steps of "correlating the first and second records" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." To properly modify Geer to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Geer. Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Geer as taught by Josephson, Cahill and Ramsay, so the proposed modification fails. In fact, Geer, Josephson, Cahill and Ramsay are improperly combined and lack proper motivation. Even if the combination of Geer, Josephson, Cahill and Ramsay could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Appellants.

The mere fact that Geer, Josephson, Cahill and Ramsay can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found

in the prior art, not in Appellants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Furthermore, the fact that four disparate references are needed in combination to address Appellants' claimed invention further supports a finding of non-obviousness. The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. Donald S. Chisum, *Chisum on Patents* §5.04[I][e][6] (2002).

F. Dependent claims 2-6, 8-10, 37-41 and 43-45 are Each Separately Patentable Over Geer, Josephson, Cahill and Ramsay

The remaining claims depend ultimately from independent claims 1 and 36 and, as such, contain the features recited in claims 1 and 36. As discussed above, the proposed combinations fail to suggest or disclose each feature recited in claims 1 and 36 and, therefore, also fails to suggest or disclose at least these same features in the dependent claims. For at least this reason, Appellants respectfully submit that the rejections of the pending claims are improper and request that they be withdrawn. Additionally, these claims are separately patentable over the proposed combination of references for at least the reasons stated below.

1. Claim 2 is Separately Patentable

Claim 2 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *performing financial processing with respect to each of the first records*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 2. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

2. Claim 3 is Separately Patentable

Claim 3 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the financial processing comprises posting the banking transaction*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 3. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

3. Claim 4 is Separately Patentable

Claim 4 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the step of correlating the first and second records further comprises performing a proofing process*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 4. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

4. Claim 5 is Separately Patentable

Claim 5 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *prior to the proofing process, sorting the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 5. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

5. Claim 6 is Separately Patentable

Claim 6 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 6. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

6. Claim 8 is Separately Patentable

Claim 8 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *storing the digital images in an archive*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 8. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

7. Claim 9 is Separately Patentable

Claim 9 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *generating first digital images of paper-based banking transactions that were not represented in the ECP file*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 9. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

8. Claim 10 is Separately Patentable

Claim 10 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *generating second digital images of the paper-based banking transactions that were represented in the ECP file and storing the first and the second digital images in an archive*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 1. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 10. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

9. Claim 37 is Separately Patentable

Claim 37 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the first processor further performs financial processing with respect to each of the first records*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 37. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

10. Claim 38 is Separately Patentable

Claim 38 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *an account system coupled to the first processor, wherein the financial processing by the first processor comprises posting the banking transaction in the account system*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 38. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

11. Claim 39 is Separately Patentable

Claim 39 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the correlating by the third processor further comprises the third processor performing a proofing process*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 39. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

12. Claim 40 is Separately Patentable

Claim 40 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *prior to the proofing process, the third processor sorts the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process by the third processor*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 40. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

13. Claim 41 is Separately Patentable

Claim 41 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every

limitation of claim 41. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

14. Claim 43 is Separately Patentable

Claim 43 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *an archive coupled to the second processor, the archive storing the digital images*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 43. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

15. Claim 44 is Separately Patentable

Claim 44 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *a scanner, the scanner generating first digital images of paper-based banking transactions that were not represented in the ECP file*. The Office Action's rejection of this claim is improper for the reasons set forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 44. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

16. Claim 45 is Separately Patentable

Claim 45 is separately patentable because the combination of Geer, Josephson, Cahill and Ramsay fails to disclose *a second scanner coupled to the first processor, the second scanner generating second digital images of the paper-based banking transactions that were represented in the ECP file and an archive coupled to the first processor, the archive storing the first and the second digital images*. The Office Action's rejection of this claim is improper for the reasons set

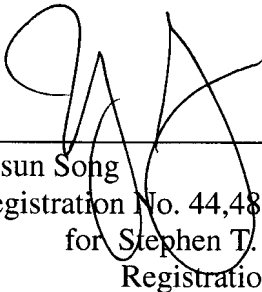
forth above with respect to claim 36. The combination of Geer, Josephson, Cahill and Ramsay fails to show each and every limitation of claim 45. In addition, there is no teaching or motivation to modify any of the applied references to include this feature.

VIII. CONCLUSION

In view of the foregoing, Appellants respectfully request that the Board reverse the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

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APPENDIX A - PENDING CLAIMS

CLAIMS

1. (Previously Presented) A method of processing banking transactions comprising:
receiving an electronic cash presentment (ECP) file, the ECP file containing first records representing paper-based banking transactions;
for each of the first records, assigning a unique first item sequence number to each respective first record;
receiving the paper-based banking transactions after having received the ECP file;
generating second records representing the paper-based banking transactions;
generating digital images of the paper-based banking transactions;
for each of the second records, assigning a unique second item sequence number to each respective second record;
correlating the first and second records; and
discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.
2. (Original) The method according to claim 1, further comprising performing financial processing with respect to each of the first records.
3. (Original) The method according to claim 2, wherein the financial processing comprises posting the banking transaction.
4. (Original) The method according to claim 1, wherein the step of correlating the first and second records further comprises performing a proofing process.

5. (Original) The method according to claim 4, further comprising, prior to the proofing process, sorting the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process.
6. (Original) The method according to claim 5, wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paper-based banking transaction.
7. (Canceled)
8. (Previously Presented) The method according to claim 1, further comprising storing the digital images in an archive.
9. (Original) The method according to claim 1, further comprising generating first digital images of paper-based banking transactions that were not represented in the ECP file.
10. (Original) The method according to claim 9, further comprising:
generating second digital images of the paper-based banking transactions that were represented in the ECP file; and
storing the first and the second digital images in an archive.
- 11.-35. (Canceled)
36. (Previously Presented) A system for processing banking transactions comprising:
a first processor, the first processor receiving an electronic cash presentment (ECP) file, the ECP file containing first records representing paper-based banking transactions, the first processor assigning a unique first item sequence number to each respective first record;

a second processor, the second processor receiving the paper-based banking transactions after the first processor received the ECP file, the second processor generating second records representing the paper-based banking transactions, the second processor assigning a unique second item sequence number to each respective second record;

a scanner coupled to the second processor for generating digital images of the paper-based banking transactions; and

a third processor correlating the first and second records and discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number.

37. (Original) The system according to claim 36, wherein the first processor further performs financial processing with respect to each of the first records.

38. (Original) The system according to claim 37, further comprising an account system coupled to the first processor, wherein the financial processing by the first processor comprises posting the banking transaction in the account system.

39. (Original) The system according to claim 36, wherein the correlating by the third processor further comprises the third processor performing a proofing process.

40. (Original) The system according to claim 39, wherein, prior to the proofing process, the third processor sorts the ECP file according to a key to generate an index file, wherein the order of the second records is thereby irrelevant in the proofing process by the third processor.

41. (Original) The system according to claim 40, wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first

item sequence number and a payor bank number, each being associated with the paper-based banking transaction.

42. (Canceled)

43. (Original) The system according to claim 42, further comprising an archive coupled to the second processor, the archive storing the digital images.

44. (Original) The system according to claim 36, further comprising a scanner, the scanner generating first digital images of paper-based banking transactions that were not represented in the ECP file.

45. (Original) The system according to claim 44, wherein the scanner is a first scanner, the system further comprising:

a second scanner coupled to the first processor, the second scanner generating second digital images of the paper-based banking transactions that were represented in the ECP file; and

an archive coupled to the first processor, the archive storing the first and the second digital images.

46.-66. (Canceled)

APPENDIX B - EVIDENCE

None

APPENDIX C - RELATED PROCEEDINGS

None.